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OFFICE OF PETITIONS

GENENTECH INC
1 DNA WAY
SOUTH SAN FRANCISCO CA 94080

In re Application	:	
Eaton, et al.	:	
Application No. 10/015,967	:	DECISION ON PATENT TERM
Filed: December 7, 2001	:	ADJUSTMENT
Attorney Docket No. 22338-501	:	

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. 1.705(b)," filed April 24, 2007, requesting correction of the initial determination of patent term adjustment (PTA) from zero (0) days to two hundred ninety-eight (298) days.

The application for patent term adjustment is GRANTED.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is **two hundred ninety-eight (298) days**. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On January 24, 2007, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above identified application. The Notice stated that the patent term adjustment (PTA) to date is zero (0) days. On April 24, 2007,

Applicants timely¹ submitted the instant application for patent term adjustment, asserting that the correct number of days of PTA at the time of the mailing of the Notice of Allowance is two hundred ninety-eight (298) days.

Applicants assert entitlement to a patent term adjustment of two hundred ninety-eight (298) days on the basis that the PTO improperly assessed Applicants a delay of four hundred forty-two (442) days for filing an Amendment and an Information Disclosure Statement (IDS) on November 16, 2006, after Applicants had filed a Request for Reinstatement of Appeal and Appeal Brief on August 31, 2005.

Applicants state that the patent issuing from the application is not subject to a terminal disclaimer.

The Office initially determined a patent term adjustment of zero (0) days based on an adjustment for PTO delay of forty-two (42) days pursuant to 35 U.S.C. 154(b)(1)(A)(i) and 37 C.F.R. § 1.703(a)(1), one (1) day pursuant to 35 U.S.C. 154(b)(1)(A)(ii) and 37 C.F.R. § 1.703(a)(2), and three hundred eighty-nine (389) days pursuant to 35 U.S.C. 154(b)(1)(A)(iv) and 37 C.F.R. § 1.703(a)(4), reduced by Applicants' delays of four hundred forty-two (442) days pursuant to 35 U.S.C. 154(b)(2)(C)(i) and 37 C.F.R. § 1.704(c)(8) and forty-four (44) and ninety (90) days pursuant to 35 U.S.C. 154(b)(2)(C)(ii) and 37 C.F.R. § 1.704(b).

A review of the application file reveals that the Amendment filed on November 16, 2006, contained a statement that it was being filed in response to a request from the Examiner. Further, the Amendment and IDS were filed after the filing of an appeal brief, when the application continued to be under appeal. Under the circumstances, no applicant delay should have been assessed.


Accordingly, the correct determination of PTA at the time of mailing of the Notice of Allowance is **two hundred ninety-eight (298) days** (432 days of PTO delay and 134 (90+44) days of applicant delay).

The \$200 fee under 37 C.F.R. 1.18(e) has been charged to Deposit Account No. 18-1260, as authorized.

The matter is being forwarded to the Office of Patent Publication for processing into a patent.

¹ Applicants filed the application for patent term adjustment together with the payment of the issue fee.

Telephone inquiries specific to this matter should be directed to
Cliff Congo, Petitions Attorney, at (571)272-3207.



Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enc: updated PAIR screen (2 pages)

Day : Wednesday

PALM INTRANET

Date: 9/12/2007

Time: 17:36:27

PTA Calculations for Application: 10/015967

Application Filing Date:	12/07/2001	PTO Delay (PTO):	432
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	576
Post-Issue Petitions:	0	Total PTA (days):	298
PTO Delay Adjustment:	442		

File Contents History

Number	Date	Contents Description	PTO	APPL	START
87	09/12/2007	ADJUSTMENT OF PTA CALCULATION BY PTO	442		
70	01/24/2007	MAIL NOTICE OF ALLOWANCE	389		60
69	01/22/2007	ISSUE REVISION COMPLETED			
68	01/22/2007	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
67	01/22/2007	NOTICE OF ALLOWABILITY			
66	12/14/2006	DATE FORWARDED TO EXAMINER			
65	11/16/2006	SUPPLEMENTAL RESPONSE		442	60
64	08/30/2006	MISCELLANEOUS INCOMING LETTER			
63	09/09/2005	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
61	12/14/2006	DATE FORWARDED TO EXAMINER			
60	08/31/2005	APPEAL BRIEF FILED			
59	08/31/2005	NOTICE OF APPEAL FILED			
58	06/03/2005	MAIL NON-FINAL REJECTION			
57	05/31/2005	NON-FINAL REJECTION			
45	03/24/2005	DATE FORWARDED TO EXAMINER			
44	03/18/2005	APPEAL BRIEF FILED			
43	03/18/2005	REQUEST FOR EXTENSION OF TIME - GRANTED			
42	03/23/2005	MAIL ADVISORY ACTION (PTOL - 303)			
41	03/18/2005	ADVISORY ACTION (PTOL-303)			
40	02/23/2005	DATE FORWARDED TO EXAMINER			
39	02/15/2005	AMENDMENT/ARGUMENT AFTER NOTICE OF APPEAL			
38	02/15/2005	REQUEST FOR EXTENSION OF TIME - GRANTED			

37	09/21/2004	MAIL ADVISORY ACTION (PTOL - 303)			
36	09/20/2004	ADVISORY ACTION (PTOL-303)			
35	08/31/2004	DATE FORWARDED TO EXAMINER			
34	08/19/2004	AMENDMENT/ARGUMENT AFTER NOTICE OF APPEAL			
33	08/19/2004	NOTICE OF APPEAL FILED		44	29
32	08/19/2004	REQUEST FOR EXTENSION OF TIME - GRANTED			
31	08/19/2004	REQUEST FOR EXTENSION OF TIME - GRANTED			
30	08/19/2004	WORKFLOW INCOMING AMENDMENT IFW			
29	04/06/2004	MAIL FINAL REJECTION (PTOL - 326)	1		25
28	04/05/2004	FINAL REJECTION			
27	12/05/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		0	25
26	02/04/2004	DATE FORWARDED TO EXAMINER			
25	12/05/2003	RESPONSE AFTER NON-FINAL ACTION		90	23
24	12/05/2003	REQUEST FOR EXTENSION OF TIME - GRANTED			
23	06/06/2003	MAIL NON-FINAL REJECTION			
22	06/02/2003	NON-FINAL REJECTION			
21	04/11/2003	DATE FORWARDED TO EXAMINER			
20	04/07/2003	RESPONSE TO ELECTION / RESTRICTION FILED			
19	03/07/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
18	03/21/2003	MAIL RESTRICTION REQUIREMENT	42		-1
17	03/20/2003	REQUIREMENT FOR RESTRICTION / ELECTION			
16	01/21/2003	CASE DOCKETED TO EXAMINER IN GAU			
15	04/08/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
14	08/09/2002	APPLICATION DISPATCHED FROM OIPE			
13	08/09/2002	APPLICATION IS NOW COMPLETE			
11	06/05/2002	ADDITIONAL APPLICATION FILING FEES			
10	06/05/2002	A SET OF SYMBOLS AND PROCEDURES, PROVIDED TO THE PTO ON A SET OF COMPUTER LISTINGS, THAT DESCRIBE IN			
9	06/05/2002	SMALL ENTITY STATEMENT (37 CFR 1.27)			
8	06/05/2002	A STATEMENT BY ONE OR MORE INVENTORS SATISFYING THE REQUIREMENT UNDER 35 USC 115, OATH OF THE APPLIC			

7	07/03/2002	CRF IS GOOD TECHNICALLY / ENTERED INTO DATABASE			
6	05/15/2002	NOTICE MAILED--APPLICATION INCOMPLETE-- FILING DATE ASSIGNED			
3	04/16/2002	IFW SCAN & PACR AUTO SECURITY REVIEW			
2	04/12/2002	IFW SCAN & PACR AUTO SECURITY REVIEW			
1	12/07/2001	INITIAL EXAM TEAM NN			

Search Another: Application#

Search

EXPLANATION OF PTA CALCULATION

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